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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,217	10/13/2000	Yoshiaki Tomotake	2000-1428A	3623

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 02/13/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/673,217

Applicant(s)

TOMOTAKE ET AL.

Examiner

Lawrence D Ferguson

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#13

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8. 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. This action is in response to the RCE mailed December 16, 2002.
Claims 5-8 were canceled and new claims 9-11 were added and are pending.

Claim Rejections – 35 USC 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. In claim 10, the phrase, “a coating applied to such an extent as not to exceed” is indefinite. ‘Applied to such an extent as not to exceed’ does not provide a requisite degree.

Claim Rejections – 35 USC § 103(a)

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suenaga et al (U.S. 6,133,170) in view of Kondo et al (U.S. 6,000,794).

6. Suenaga discloses mercerized pulps (column 7, line 5) having weight percentage in the range from 10 to 100% (column 7, lines 12-13). Suenaga discloses coating recording paper and copying paper (column 9, lines 17-26). The reference is silent as to the coating, which is applied for improving ink absorption as per instant claim 9. Since no such coating is disclosed as being applied, the limitation of claim 9 is met. Suenaga does not disclose the liquid transfer length in the Bristow method as being 100 mm or less. The determination of the liquid transfer length by Bristow's method is according to J. Tappi No. 51-87 is a product by process limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966. Although the reference does not explicitly disclose ink jet recording paper, one of ordinary skill in the art would commonly use ink jet recording paper, which serves the same function as the copying and recording paper. Suenaga does not disclose a recording paper having a high ink coloring density and high ink absorption speed.

Kondo teaches a recording medium that teaches a high color density (column 3, lines 38-56) and a high ink absorption speed (column 4, lines 57-58). Suenaga and Kondo are analogous art because they are both directed to recording mediums. It would

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have been obvious to one of ordinary skill in the art to include the high color density and high ink absorption speed in the recording paper of Suenaga because Kondo teaches the color density becomes higher to increase smoothness (column 3, lines 53-56) and the ink absorption speed is high to reduce beading of the recording medium (column 4, lines 56-61).

Claim Rejections – 35 USC § 103(a)

7. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/00541 in view of Kondo et al (U.S. 6,000,794).

8. WO '541 teaches ink jet printable paper with fibers (page 1, lines 9-27) with 0 to about 70 percent by weight of mercerized fibers (page 1, lines 36-37). The reference is silent as to the coating, which is applied for improving ink absorption as per instant claim 9. Since no such coating is disclosed as being applied, the limitation of claim 9 is met. WO '541 does not disclose the liquid transfer length in the Bristow method as being 100 mm or less. The determination of the liquid transfer length by Bristow's method is according to J. Tappi No. 51-87 is a product by process limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re*

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Thorpe, 227 USPQ 964, 966. WO '541 does not disclose a recording paper having a high ink coloring density and high ink absorption speed.

Kondo teaches a recording medium that teaches a high color density (column 3, lines 38-56) and a high ink absorption speed (column 4, lines 57-58). WO '541 and Kondo are analogous art because they are both directed to printable recording mediums. It would have been obvious to one of ordinary skill in the art to include the high color density and high ink absorption speed in the recording paper of WO '541 because Kondo teaches the color density becomes higher to increase smoothness (column 3, lines 53-56) and the ink absorption speed is high to reduce beading of the recording medium (column 4, lines 56-61).

Response to Arguments

9. Arguments made in regards to rejection made under 102(e) as being anticipated by Suenaga et al (U.S. 6,133,170) are moot due to Applicant canceling claim 5. Arguments made in regards to rejection made under 35 U.S.C. 103(a) as being unpatentable over Suenaga et al (U.S. 6,133,170) are moot due to Applicant canceling claims 5-8. Arguments made in regards to rejection made under 35 U.S.C. 102(b) as being anticipated over WO 99/00541 are moot due to Applicant canceling claim 5. Arguments made in regards to rejection made under 35 U.S.C. 103(a) as being unpatentable over WO 99/00541 are moot due to Applicant canceling claims 5-7.

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA M. KELLY
SUPERVISOR
TELEPHONE 308-0449

